

Appl. No. 10/820,590
Docket No. 9031R
Amdt. dated June 26, 2009
Reply to Office Action mailed on January 29, 2009
Customer No. 27752

REMARKS

Claim Status

Claims 1-3, 5-8, 10-12, and 17-26 are pending in the present application. No additional claims fee is believed to be due.

Claim 9 is canceled without prejudice.

Claims 1, 2 and 10 are amended. Support for the amendment to claim 1 is found, for example, in previous claim 9. Support for the amendment to claim 2 can be found, for example, at page 12 of the specification. Support for the amendment to claim 10 can be found, for example, at pages 3 and 4 of the specification.

In addition, new claims 24-26 are added. Support for claim 24 can be found, for example in Figs. 1 and 8 of the specification. Support for claim 25 can be found, for example, at page 4 of the specification. Support for claim 26 can be found, for example, at page 12 of the specification.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC §112, Second Paragraph

The Office Action States claims 17, 18, and 22 are rejected under 35 USC §112, second paragraph. Claims 17 and 18 are rejected for the use of “substantially” while claim 22 is rejected for use of “less than about.” Applicants traverse this rejection and respectfully request reconsideration.

With regard to the use of the term “substantially,” MPEP 2173.05(b) discusses the use of the term substantially and gives two examples of where substantially was found to be definite by the Federal Circuit. Applicants submit that similar to “substantially equal” which the Federal Circuit found to be definite, one of ordinary skill in the art would know what was meant by “substantially coextensive” (claim 17) and “substantially water impermeable” (claim 18) *see Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819 (Fed. Cir. 1988).

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With respect to the use of “less than about,” Applicants disagree with the Office Action’s assertion that there is a conflict of terms when using the combination of less than and about. The phrase “less than” modifies the term “about 1 mm.” Thus, even if the use of “about” before 1 mm allows for a number greater than 1 mm, there is no conflict of terms. For example, if “about 1 mm” was equivalent to 1.1 mm, then the claim would read less than 1.1 mm. As can be seen from the example, there is no conflict of terms with the use of “less than” to modify the term “about 1 mm.”

Rejection Under 35 USC §103(a) Over Godbey in view of Chang
and Sagel

Claims 1-3, 5-8, 11-12, 17-23 were rejected under 35 USC §103(a) as being unpatentable over Godbey et al. (US 2002/0187181) (Godbey) in view of Chang et al. (US 2003/0194382) (Chang) and Sagel et al. (US 5,891,453) (Sagel). This rejection is traversed and reconsideration is respectfully requested.

Amended independent claim 1 recites a packaged tooth whitening product, comprising a backing layer and a layer of a tooth whitening composition comprising first and second polymers, from about 10% to about 90% water, and a tooth whitening agent, wherein said first polymer is polyethylene oxide having an average molecular weight between about 300,000 and about 900,000 and said second polymer is polyvinyl alcohol. The Office Action points to no teaching in Godbey, Chang, or Sagel relating to all of the limitations of currently amended claim 1 like for example, wherein the polyethylene oxide has an average molecular weight between about 300,000 and about 900,000. As the Office Action has failed to show teaching of all of the limitations of amended claim 1 in Godbey, Chang, and Sagel, it does not establish a *prima facie* case of obviousness (see MPEP 2143.03). As such, Applicants submit that independent claim 1 and all claims dependent thereon are non-obvious over Godbey in view of Chang and Sagel. Reconsideration is respectfully requested.

Rejection Under 35 USC §103(a) Over Godbey in view of Chang,
Sagel, and Xu

Claims 9-10 are rejected under 35 USC §103(a) as being unpatentable over Godbey et al. in view of Chang et al. and Sagel et al. in further view of Xu et al. (US

2002/0187111) (Xu). This rejection is traversed and reconsideration is respectfully requested.

Claim 9 has been cancelled and claim 10 depends from claim 1, the substance of claim 1 is recited above. The Office Action states that Godbey teaches “adhesive compositions [which] also include cold water-soluble polymers, such as poly(ethylene oxide) (paragraph 0036), and the polymers may be an uncross-linked polymer or mixture of polymers with an average molecular weight between 10,000 and 100,000 Daltons. Such polymers provide a good balance of cohesive strength and water-solubility” (Page 4). The Office Action goes on to state that Xu teaches “[t]he polymer is hydratable and varying the properties of the polymer can control the release of the whitening agent. Varying film thickness and using a mixture of different molecular weight polyethylene oxide polymers (100,000 – 1,500,000 Daltons) varies the properties of the films” (Page 6). The Office Action finally states that it would have been obvious to one of skill in the art to have used polyethylene oxides of different molecular weights as in the composition of Godbey motivated by the desire to make a whitening composition that provides good balance of cohesive strength, etc. as disclosed by Xu.

Applicants contend that the teachings of Godbey and Xu as it relates to the molecular weight of polymers in the adhesive layer are adverse, not complimentary as the Office Action suggests. Godbey’s statements, as quoted above in the Office Action, relate the use of lower molecular weight polymers in its adhesive layer (less than 100,000 Daltons) to have a good balance of cohesive strength and water solubility. Looking to this statement, one would believe a good balance of cohesive strength and water solubility in Godbey would require a polymer with a molecular weight between about 10,000 and 100,000 Daltons. On the other hand, Xu states that its “film comprising an anhydrous water hydratable polyethylene oxide polymer matrix” can use “homopolymers or mixtures of ethylene oxide polymers of varying molecular weight ranging from about 10,000 Daltons and up to about 10,000,000 Daltons” (Abstract, Paragraph 10), Godbey teaches away from the use of polymers in its adhesive layer with a molecular weight greater than 100,000 Daltons as it implies that a polymer must be within that range in order to give the desired balance of cohesive strength and water-solubility. As Examiner is aware, it is error to find obviousness when a reference diverges from and teaches away from the invention at hand, *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988).

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In light of the above, Applicants submit that claim 1 and those claims dependent thereon are nonobvious over Godbey in view of Chang, Sagel, and Xu. Reconsideration is respectfully requested.

Newly Added Claims 24-26

Newly added claims 24-26 depend from independent claim 1. In light of the arguments made above regarding Godbey in view of Chang, Sagel, and Xu relating to claim 1, Applicants submit that these newly added claims are also nonobvious over the applied references.

Nonstatutory ("Obviousness-Type") Double Patenting Rejection

Claims 1-12, 17, 18, and 23 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/936,756. Applicants traverse this rejection and submit that Application No. 10/936,756 is now abandoned mooted this rejection. Reconsideration is respectfully requested.

Conclusion

This response represents an earnest effort to place the present application in proper form and to distinguish the invention as claimed from the applied references. In view of the foregoing, entry of the amendments presented herein, reconsideration of this application, and allowance of the pending claims are respectfully requested.

Respectfully submitted,

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